



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/657,431	09/07/2000	Dominique P. Bridon	REDC-2201 USA	1545

20872 7590 11/19/2002
MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

EXAMINER

CHISM, BILLY D

ART UNIT	PAPER NUMBER
----------	--------------

1654

DATE MAILED: 11/19/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/657,431

Applicant(s)

BRIDON ET AL.

Examiner

Billy D Chism

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 19 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office Action is in response to Paper Number 8, filed on 17 October 2002, wherein Applicants elected Group I, claims 1-16 and 19-20, and Applicants canceled claims 17 and 18. In the Restriction Requirement, the examiner failed to include claim 21 in Group I, and in Applicants' response there was no election to claim 21. However, the examiner included the claim 21 in consideration of Group I, thus, this action pertains to examination of Group I, claims 1-16 and 19-21.

Claim Objections

1. Claim 21 is objected to because of the following informalities: claim 21 (page 71, line 6) is followed by the number "20", thus, Applicants should delete the "20". Appropriate correction is required.

Information Disclosure Statement

2. Applicants are hereby notified that the references lined through on the attached Form PTO-1449 have not been considered as no copy was found with application. Applicants should submit documents listed in IDS, Paper No. 4, filed on 09 February 2001, for examiner's review. Those documents initialed by examiner, were results of searches of the prior art.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1653

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/41824 (Davidson 1997).

Davidson 1997 teaches a pharmaceutically acceptable salt of a kringle 5 peptide derivative (page 21) wherein the salt is formed by use of maleic acid and succinic acid and wherein the pharmaceutically acceptable salt of a kringle 5 peptide derivative is used for inhibiting angiogenesis and treating angiogenic diseases (abstract; pages 2-3). Claims 1-16 and 19 of present application teach a modified antiangiogenic peptide with a reactive group (succinimidyl or maleimido) as in Davidson 1997, for the treatment of angiogenic diseases. Furthermore, Davidson 1997 teaches the peptide sequences of SEQ ID NOs: 8, 11, 13 and 15 of claims 5-6, 11-12, 15-16 and 19 (Davidson 1997, see examples 5, 9, 6 and 7 respectively).

5. Claims 1-4, 6-10, 12-14, 16 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Davidson (US 6,057,122; filed May 5, 1997; issued May 02, 2000).

Art Unit: 1653

Davidson teaches a pharmaceutically acceptable salt of a kringle 5 peptide derivative (column 18 lines 5-43) wherein the salt is formed by use of maleic acid and succinic acid and wherein the pharmaceutically acceptable salt of a kringle 5 peptide derivative is used for inhibiting angiogenesis and treating angiogenic diseases (abstract; column 2 lines 64-67). Claims 1-4, 7-10 and 13-14 of present application teach a modified antiangiogenic kringle 5 peptide with a reactive group (succinimidyl or maleimido) as in Davidson, for the treatment of angiogenic diseases. Furthermore, Davidson teaches the peptide sequences of SEQ ID NOs: 15-16 of claims 6, 12, 16 and 19 (Davidson, SEQ ID NO: 18 and example 4 column 36, respectively).

Conclusion

6. Claim 20 was not objected to or rejected but is not allowable without consideration of documents lined through on Form PTO-1449 and which Applicants are requested to submit. Objection to claim 21, claims 1-16 and 19 are rejected, and Applicants canceled claims 17-18 without prejudice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. Dell Chism whose telephone number is 703-306-5815. The examiner can normally be reached on 7:30 AM - 4:30 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 703-306-3220. The fax phone numbers for the

Application/Control Number: 09/657,431

Page 5

Art Unit: 1653

organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

B. Dell Chism
18 November 2002

Brenda Brumback
BRENDA BRUMBACK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600